



FEB 04 2002

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In re Application of SAIED et al.

Application No.: 09/600,073

PCT No.: PCT/FR99/00040

Int. Filing: 12 January 1999

Priority Date: 12 January 1998

Attorney Docket No.: 1029/00205

For: METHOD FOR EXPLORING AND
DISPLAYING TISSUE OF HUMAN OR
ANIMAL ORIGIN FROM A HIGH
FREQUENCY ULTRASOUND PROBE

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 12 September 2001. Applicants requested a one month extension of time, which is granted.

BACKGROUND

On 03 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. The notification set a one month time limit in which to respond.

On 05 February 2001, applicants, in response to 03 August 2000 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Michel Puech, on the grounds that the non-signing inventor refused to execute the declaration.

On 12 June 2001, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed to applicants indicating that applicants had not demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature. sent to his last known address and had not demonstrated Mr. Puech's refusal to sign, either in writing or

by telephone, these documents.

On 12 September 2001, applicants filed a renewed petition under 37 CFR 1.47(a) including a statement of the efforts to reach the non-signing inventor by Chantal Peaucelle, having first-hand knowledge of the refusal.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3), and (4) have been submitted, satisfying the requirements of 37 CFR 1.47(a).

With respect to item (2), where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers, and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.

Here, Petitioner submitted a statement of facts under 37 CFR § 1.47(a)(2) executed by Chantal Peaucelle, the person claiming first hand knowledge of the refusal. The statement indicates that on 23 July 2001, Chantal Peaucelle sent a copy of the application by registered mail to Michel Puech, the non-signing inventor. A copy of the cover letter and an English translation were provided. On 27 July 2001, Ms. Peaucelle phoned Mr. Puech and spoke with his secretary. Thereafter Mr. Puech "returned the phone call and indicated that he had received the mentioned patent application papers but has been repeatedly told by his attorney, Mr. Francis Ahner, of the French patent law firm Cabinet Regimbeau, to refuse to sign. The reason for the refusal is the fact that Mr. Puech filed a separate application in the U.S. on his own behalf."

Mr. Puech was presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application. The statement that Mr. Puech was advised by his attorney not to sign the application papers and has not, in fact, returned the papers with his signature is sufficient evidence to conclude that applicant/inventor Michel Puech has refused to sign the application.

Petitioner has demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Puech's oral refusal to sign these documents.

In sum, the evidence submitted supports a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

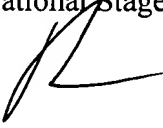
CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 05 February 2001 and to mail a filing receipt. The application has an international filing date of 12 January 1999 under 35 U.S.C. 363, and a date of 05 February 2001 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.



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NOTIFICATION

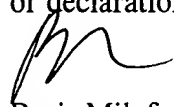
UNDER


37 CFR 1.47(a)

Dear Mr. Puech:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of a national stage application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Michel Puech) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/FR99/00040 and was filed on 12 January 1999 in the names of Amena Saied, Genevieve Berger, Pascal Laugier and Michel Puech for the invention entitled Method for Exploring and Displaying Tissues of Human or Animal Origin From a High Frequency Ultrasound Probe. The national stage application is assigned number 09/600,073 and has a 35 U.S.C. 371(c) date of 05 February 2001.